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In re Application of
Falk Fish
Serial No.: 09/763,415
Filed: May 16, 2001
Attorney Docket No.: FISH-4

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: PETITION DECISION
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This is in response to the petition under 37 CFR 1.181, filed September 30, 2003, for withdrawal of abandonment of the above identified application based on filing of a timely reply.


A review of the file history shows that the examiner mailed a Final Office action to applicant on March 20, 2003, setting a three month shortened statutory period for reply. Applicants replied with an amendment on July 21, 2003, including a one month extension of time (refaxed on August 19, 2003). The amendment did not place the application in condition for allowance and an Advisory action was prepared, but never mailed to applicant (a copy is enclosed with this decision). A Notice of Abandonment was mailed to applicant on September 16, 2003, when no further reply was filed. This Notice was mailed prematurely – one week before abandonment occurred by action of law. Applicant filed RCE papers on September 22, 2003, accompanied by a further two month extension of time request and fee and the RCE filing fee. The reply has now been located and placed in the file. In view of the Office error and timely reply the Notice of Abandonment was mailed in error and is withdrawn and the application is restored to pending status with the mailing of this decision.

However, applicant's request for refund of the second and third month extension of time fees is not approved. Refund of such fees would only be approved if the reply to the Final Office action were filed within two months of the mail date thereof. Request for patent term adjustment is premature as the application has not been found allowable.

The petition is **GRANTED**.

The application will be forwarded for entry of the RCE papers and then to the examiner for further action.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 703-308-3824 or by facsimile sent to the general Office facsimile number 703-872-9306.



Bruce M. Kisliuk
Director, Technology Center 1600

Advisory Action

Application No.

09/763,415

Applicant(s)

FISH, FALK

Examiner

Ja-Na A Hines

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-12.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The after final amendment will not be entered because it raises issues that require further search and consideration. Originally the claims were drawn to a method for determining the level of an analyte; and now the claims are drawn to determining the level of glucose. Thus, the method now recites the glucose limitation. Furthermore, the claims now limit the sample to being of hair or urine, whereas previously there was no limitation on the sample type. Thus the claims are now limited in both the type of analyte determined and the sample type.

Applicant argues that the claims do not require a specific detection step. However, it is the examiner's position that the claims fail to specifically state what measurement techniques are being employed. Merely stating that determination will occur without describing the steps is inadequate, and applicants arguments are not persuasive. There is no recitation of how the analyte, now glucose will be measured. There is no contact step wherein the hair or urine sample is contacted with the reagents required to determine the volume or amount of blood or glucose. There is no detection step which detects the volume or amount of blood and analyte. There is still no correlation step which correlates determining the amount of analyte and blood in a sample to the level of analyte in the blood of the sample donor. The claims must positively recite method steps. Despite applicants argument that one of skill in the art could figure out which detection steps are necessary to determine the different levels needing comparison, the claims still amount to gaps between the steps since there is no contacting step or detection step that would enable the measurement of glucose from a sample. Therefore, the rejections are maintained.